

<b>ADDITIONAL FEE</b>
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<b>REMARKS</b>
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Claim 1 has been amended to address the 112, second paragraph issues raised by the examiner (support for the "effective amount" limitation can be found throughout the specification, e.g. page 9, lines 1-4). Claims 11 and 12 have been added and represent the separate limitations cited in (b) of old claim 1. It is believed that no new matter has been added.

***35 U.S.C. 112, second paragraph rejection***

Claim 1 was rejected as being vague and indefinite for a number of reasons. With respect to the use of the phrase "also optionally further substances", "including", "preferably", "in particular", "primarily" and "an effective amount", it is believed that the amendments made address the examiner's concerns.

Setting aside the rejection of the use of the term "and/or" temporarily, it is unclear why the phrase "chosen from the group of emulsifiers having the following properties" is vague and indefinite, i.e. one of ordinary skill in the art would recognize that the scope of this limitation would include property #1 and property #2 or property #2 alone.

With regard to the use of the term "and/or", there is no restriction against the use of multiple conjugates (a quick search of PTO patent database for 1996-2002 shows 35,542 issued patents as of the date of this response which uses this terminology in the claim). If this is the only issue preventing an allowance of the claims, the examiner is authorized to write an Examiner's Amendment which repeats the text such that the scope of the text encompasses the scope of the limitation which includes property #1 and property #2 or property #2 alone. However, the examiner is reminded that MPEP 2173.02 states that:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, ***not whether more suitable language or modes of expression are available***. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, ***but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement***. (see MPEP 2173.02)

### ***35 U.S.C. 102(b) rejection***

Claims 1-3 and 5-8 (now represented by claims 1-3 and 5-10) were rejected by the examiner as being anticipated by Richard et al. (U.S. Patent 5,900,231). The applicants request reconsideration for the following reasons.

First, the Richard et al. reference uses karite *oil* (i.e. the liquid form) whereas the applicants claims are directed toward the use of shea *butter* (i.e. the solid form).

Second, the Richard et al. reference is primarily directed toward compounds and compositions with organosiloxanes derivatized by salicylic acid. While emulsifiers can be present in the composition forms, there is no teaching or suggestion as to the specific combination of emulsifiers as used by the applicants.

### ***35 U.S.C. 103(a) rejection***

Claims 1-3 and 6-9 (now represented by claims 1-3 and 6-10) were rejected by the examiner as being obvious over Zabotto et al. (U.S. Patent 4,661,343) in view of Gohla et al. (U.S. Patent 5,750,124)

Claims 4 and 5 were rejected by the examiner as being obvious over Zabotto et al. (U.S. Patent 4,661,343) in view of Gohla et al. (U.S. Patent 5,750,124) and further in view of Muller et al. (U.S. Patent 4,719,239).

The applicants request reconsideration of both rejections for the following reasons.

Zabotto et al. also uses karite oil (see discussion of Richard et al. above). As the applicants invention is directed toward the use of shea butter to reduce stickiness or greasiness in an oil-in-water emulsion, one of ordinary skill in the art would not be motivated to substitute one form of shea oil/butter for the other form.

Zabotto et al. is acknowledged by the examiner to lack a teaching on the specific properties of the emulsifier. However, the Gohla et al. reference does not remedy the difference with respect to shea oil/butter. Moreover, Gohla et al. does not remedy the deficiency with respect to the properties of the emulsifier as Gohla et al.'s emulsifiers are directed toward W/O/W emulsions (i.e. water-in-oil-in-water) whereas the applicants claimed emulsions are O/W (oil-in-water).

Even if Zabotto et al. in view of Gohla et al. had rendered claim 1-3 and 6-9 obvious, the inclusion of Muller et al. would not overcome the differences set forth in claims 4

and 5 of the applicants' invention.

First, the compositions of Muller et al. are directed toward enhancing the penetration of a pharmaceutical active agent through the skin (see col. 3, lines 1-3) not reducing the stickiness/greasiness of the emulsion. While the motivation for modifying the reference does not have to be the same as the applicants intended use, it has not been established that modifying Zabotto et al. and Gohla et al. as directed by Muller et al. intended effect would achieve the applicants' emulsions.

Second, the use of coemulsifiers in Muller et al. is contingent upon "special properties of the systems according to the invention (which) are based on the use of certain surfactant/cosurfactant combinations" (see col. 3, lines 35-37). Moreover, the disclosure of Muller et al. that "The nature and concentration of the coemulsifiers of the surfactant and cosurfactant determine both the scope of the thermodynamic, stable, single-phase range and also the viscosity of the system and the temperature range in which there is thermodynamic stability" (see col. 4, lines 33-37) merely represent an invitation to experiment; i.e. one of ordinary skill in the art would undergo undue experimentation to arrive at the applicants invention without the benefit of the applicants teachings.

Lastly, Muller et al. discloses that their multicomponent system is effected by the nature of the dissolved active agent and as such represents a critical element of their invention (see col. 4, line 66 thru col. 5, line 5) and as such cannot be ignored when determining the substitution of their teachings to that of Zabotto et al. and Gohla et al.

### *Closing*

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By Howard C. Lee

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<b>CERTIFICATE OF MAILING</b>
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I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, Washington, D.C. 20231, on the date indicated below:

Date: **23 January 2002**

By Howard C. Lee  
Howard C. Lee